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IN THE

SUPREME COURT OF THE UNITED STATES

OCTOBER TERM, 1955.

No. 761

OLIN MATHIESON CHEMICAL CORPORATION,
a Corporation, Petitioner,

v.

THE WESTERN STATES CUTLERY AND MANUFACTURING COMPANY, a Corporation; H. REGINALD PLATTS, HARLOW C. PLATTS, DEBBIE C. PLATTS, LOIS M. PLATTS, and MARIAN K. PLATTS, Doing Business under the Name and Style of WESTERN STATES CUTLERY COMPANY; and WESTERN STATES CUTLERY COMPANY, a Colorado Corporation, Respondents.

PETITION FOR WRIT OF CERTIORARI

To the United States Court of Appeals for the Tenth Circuit.

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PETITION FOR WRIT OF CERTIORARI

To the United States Court of Appeals for the Tenth Circuit.

To the Honorable, The Chief Justice and the Associate Justices of the Supreme Court of the United States:

Your Petitioner, Olin Mathieson Chemical Corporation, prays that the Court issue a writ of certiorari to review the judgment of the United States Court of Appeals for the Tenth Circuit entered in the above-entitled case on November 12, 1955.

OPINIONS BELOW.

The opinion of the Court of Appeals for the Tenth Circuit (as amended after Petition for Rehearing) is reproduced as Appendix A hereto. The opinion is reported (in its original, unamended condition) at 107 United States Patent Quarterly 257, and in its amended condition at 227 F. (2d) 728, 729.

The oral opinion of the District Court appears at pages 272-280, Volume II of the Transcript of Record, and is reproduced as Appendix B hereto. This opinion is not reported.

The opinion of an administrative agency (the Patent Office) in an inter partes proceeding between the parties hereto is reproduced as Appendix C hereto, and appears at pages 119 through 121 of Exhibit 10 in the Exhibit Book forming a part of the Transcript of Record.

JURISDICTION.

The opinion of the Court of Appeals and judgment thereon was entered on November 12, 1955. Petition for Rehearing was filed on November 29, 1955, and denied on December 16, 1955. Concurrently with the denial of the Petition for Rehearing, the opinion of the Court of Appeals was amended as indicated in Appendix A.

The statutory provision which confers on this Court jurisdiction to review the judgment of the lower Court is Title 28, United States Code, §1254(1) (June 25, 1948, ch. 646, §1, 62 Stat. 928).

QUESTIONS PRESENTED.

1. Whether the owner of a word trademark which consists of a common word in general use but which has acquired secondary meaning in a limited class of trade, is entitled to restrain use thereof by another upon goods which, although not directly competitive, nevertheless appeal to the same limited class of trade?

2. Whether §32(1) of the Trade-Mark Act of 1946 is to be construed as affording protection to trademark registrants only on the specific items of goods named in the trademark registration; or as extending such protection to closely related goods which are handled in the same trade channels, appeal to the same ultimate consumers, and are used in the same activity?

3. Is evidence that the goods of the respective parties have been:

(a) held by an administrative agency of the Federal Government, in a proceeding between the same parties, to "belong to the same general class of merchandise" and to have "the same descriptive properties" within the meaning of the Trade-Mark Act of 1905;

(b) adjacently displayed in retail establishments;

(c) used in the same activity;

(d) advertised in the same trade media;

(e) manufactured by the same concerns and sold by them under the same trademark;

(f) represented by retailers to come from the same source;

sufficient to establish that the use thereon of the same trademark is "likely to cause confusion or mistake or to

deceive purchasers as to the source of origin of such goods" within the meaning of §32(1) of the Trade-Mark Act of 1946; or is it necessary in addition to prove that ultimate consumers have actually been confused?

4. In terms of this particular case, is the Respondents' use of the trademark "WESTERN" upon hunting and outing knives likely to cause purchasers to believe that such are the product of Petitioner?

STATUTES INVOLVED.

The statutory provision primarily involved is Section 32(1) of the Trade-Mark Act of 1946 (commonly called the Lanham Act), Public Law 489, 79th Congress, Ch. 540, 60 Stat. 427 (Title 15, United States Code, § 1052, § 1114(1)). Sections 2 and 46(b) of the same Act are collaterally involved. These three sections are reproduced in their entirety as Appendix D, but the parts of Sections 2 and 32(1), here pertinent, read as follows:

§ 2

"No trade-mark by which the goods of the applicant may be distinguished from the goods of others shall be refused registration on the principal register on account of its nature unless it— * * *

"(d) Consists of or comprises a mark which so resembles a mark registered in the Patent Office or a mark or trade name previously used in the United States by another and not abandoned, **as to be likely, when applied to the goods of the applicant, to cause confusion or mistake or to deceive purchasers**" (Emphasis added).

§ 32(1)

"Any person who shall, in commerce, * * * use, without the consent of the registrant, any reproduction,

counterfeit, copy, or colorable imitation of any registered mark in connection with the sale, offering for sale, or advertising of any goods * * * on or in connection with which such use **is likely to cause confusion or mistake or to deceive purchasers as to the source of origin of such goods** * * * shall be liable to a civil action by the registrant for any or all of the remedies hereinafter provided" (Emphasis added).

Despite the fact that the Trade-Mark Act of February 20, 1905, Ch. 952, 33 Stat. 728, was repealed by the Trade-Mark Act of 1946, the Act of 1905 is involved to the extent that the Courts below seemingly followed the old law rather than the new. Sections 5 and 16 of the 1905 Act correspond, respectively, to Sections 2 and 32(1) of the 1946 Act, with the difference, however, that the norm, by which conflict of goods is measured, was changed by the 1946 Act. The difference between the two Acts in the latter respect is apparent by comparing the expressions emphasized in the above-quoted passages from the 1946 Act with those emphasized in the passages now to be quoted from Sections 5 and 16 of the 1905 Act:

§ 5

"No mark by which the goods of the owner of the mark may be distinguished from other goods of the same class shall be refused registration as a trade-mark on account of the nature of such mark unless such mark— * * *

"*Provided*, That trade-marks which are identical with a registered or known trade-mark owned and in use by another and appropriated to **merchandise of the same descriptive properties**, * * * shall not be registered" (Bold face emphasis added).

§ 16

"Any person who shall, without the consent of the owner thereof, reproduce, counterfeit, copy, or color-

ably imitate any such trade-mark and affix the same to **merchandise of substantially the same descriptive properties** as those set forth in the registration * * * shall be liable to an action for damages therefor at the suit of the owner thereof" (Emphasis added).

Sections 5 and 16 of the 1905 Act are reproduced in their entirety as Appendix E.

STATEMENT OF THE CASE.

Federal jurisdiction in the Court of first instance was predicated upon the Trade-Mark Act of 1946, as well as upon diversity of citizenship.

Prior to 1900, Western Cartridge Company adopted the trademark "WESTERN" for hunting goods of its manufacture. In the succeeding years it used and advertised that mark extensively in connection with its line of hunting goods, including: shot shells, rifle and pistol cartridges, shot for air rifles and shotguns, powder, gun wads, primers, targets and traps. Western Cartridge Company acquired four registrations (Exhibits 1-4, Exhibit Book) of the mark under the Act of 1905. In 1944, Western Cartridge Company changed its corporate name to Olin Industries, Inc., but continued to do business under the old style of Western Cartridge Company, as a division of Olin Industries, Inc. Under the latter name, it acquired five additional registrations of the mark, one (Exhibit 5) under the Act of 1905, and four (Exhibits 6-9) under the Act of 1946 on the Principal Register. Six of the registrations show the mark in a script form of writing (the Court of Appeals' opinion erroneously says that all nine were "in script"), but three (Exhibits 3, 4 and 6) show the mark in plain block letters.

The trial Court found as a fact (F. of F. 17, R. 39) that:

> "Western Cartridge Company and later as Western Cartridge Company Division of Olin Industries, Inc., is one of the best known concerns in its field and has established a place in the minds of those who use ammunition, who shoot guns and are engaged in that particular operation; that Western Cartridge Company has attained a place where its name is said to have a secondary meaning. **'Western' has become so well known that it has come to mean the Western Cartridge Company to sportsmen, to the users of goods in the field of ammunition, ammunition components, traps and targets; and that 'Western' has become a common designation for plaintiff's products.** Prior to 1927 plaintiff spent at least two million dollars in advertising its products under the trade mark 'Western'; between 1927 and 1936 the expenditures were at least one hundred thousand dollars annually; from 1937 to 1953 it aggregated more than three million dollars. This advertising has included magazine advertisements in 'Outdoor Life', 'Field and Stream', 'Sports Afield' and 'Hunting and Fishing' and other magazines circulated generally in the United States and in some foreign countries, which magazines are particularly designed to reach hunters, fishermen and trappers" (emphasis added).

and concluded as a matter of law:

> "3. Plaintiff's nine trade mark registrations involving the use of 'Western' for the products specified therein are valid and the long and continued use by plaintiff of the word 'Western' has caused said name to acquire secondary meaning when referring to plaintiff's products, but such secondary means is limited to the products upon which the mark is used or upon closely allied products having the same descriptive properties" (C. of L. 3, R. 40).

After the trial in the District Court, Olin Industries, by merger, became Olin Mathieson Chemical Corporation.

Respondents mark their hunting and outing knives "WESTERN" (simpliciter)[1] in plain block type. Some of their packages and advertising matter show the mark in script.

Petitioner has never sold knives of any sort under its "WESTERN" trademark; but hunting knives have been sold by the manufacturers of competitive brands of ammunition under the same trademark as their ammunition, to wit: "Winchester" and "Remington."

Respondent Western States Cutlery and Manufacturing Company sought, under the Trade-Mark Act of 1905, to register "WESTERN" for hunting knives, pocket knives, and outing knives. When the application was published for opposition, Petitioner's predecessor, Western Cartridge Company, instituted and litigated in the Patent Office an adversary proceeding against Respondent, with the result that the following administrative ruling was entered:

> "In view of this close association of these articles in use, as well as the fact that they are also handled by the same stores, and in some instances, as the record shows, are made and sold by the same manufacturers, it is believed that they belong to the same general class of merchandise and consequently possess the same descriptive properties within the meaning of the statute. It is so ruled."

Respondent took no appeal from that ruling.

On the trial of the case *sub judice*, Petitioner relied upon the aforesaid administrative ruling as establishing, *prima facie*, that Respondents' knives were goods of such nature that the use thereon, of the same trademark as used by

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[1]Respondent Western States Cutlery and Manufacturing Company originally used "WESTERN STATES", "WEST-CUT", "WESTACO", and some pictorial representations as its trademarks, but Petitioner complains of none of these.

Petitioner on its hunting goods, was "likely to cause confusion or mistake or to deceive purchasers as to the source of origin of such goods," as provided in § 32(1) of the Trade-Mark Act of 1946. In addition, Petitioner showed that hunting knives were customarily displayed in retail stores immediately adjacent the displays of hunting ammunition; that they were mingled together in window displays (see Ex. 56); that such products were customarily advertised in the popular outdoorsman's magazines; and that in classified advertising hunting knives are carried under the heading of "Firearms" or "Arms and Ammunition" (see Exs. 51 and 52). Other evidence tending to show the likelihood of confusion is summarized by the Court of Appeals thus:

> "This was done by offering the testimony of some paid investigators who went into stores which handled appellant's trade-marked products and also appellee's knives. They usually began by handing the clerk a list of objects sought. This list would contain an item of a box of Western shells and then a request for a knife made by Western Cartridge Company. Obviously, the store had no such knife. Sometimes the clerk would so state and at other times the clerk would get out a knife marked with appellee's trade-name[2] and hand it to the investigator with the statement that it was a good knife and that it was **made by Western Cartridge Company**" (Emphasis added).

As originally handed down, the opinion of the Court of Appeals held that the evidence:

> "was not sufficient to establish confusion in the minds of the buying public"

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[2]"Appellee's trade-name", as here used, must mean "WESTERN" because all of the knives were so marked, but none were marked with the real trade name of any of the Respondents.

but after Petition for Rehearing, wherein it was pointed out that under the Trade-Mark Act of 1946, the controlling issue was **likelihood**, not actuality, of confusion, the passage was amended to read thus:

> "was not sufficient to establish *the likelihood of* confusion in the minds of the buying public" (the italicized matter was added by amendment).

Petitioner's complaint was dismissed.

REASONS FOR THE ALLOWANCE OF THE WRIT.

I.

Public Importance and Existence of Conflict Is Demonstrated by the Numerous Petitions for the Writ Presenting Opposite Views on the Confusion of Source Aspect of the Trademark Law.

There has been much conflict among (and indeed within[3]) the several Circuit Courts of Appeal as to whether a particular segment of the public to whom a mark (consisting of a common word in general use) designates a singular source (i. e., secondary meaning) and the owner of such a mark are entitled to be shielded against confusion, mistake, or deception incident to the use of the same mark by another in an uncompetitive, but closely related, way.

The importance of the question is accented by the fact that this is the ninth Petition for the writ to present some aspect of the subject in as many years. **There are now before this Court petitions for the writ in two other cases** (Nos. 658 and 662) where the controlling issue is embraced

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[3]See Lunsford, "The Lanham Trade-Mark Act—Conflict and Dissent", 43 Trade-Mark Reporter 995, 1004-1008.

by Question 1 herein. In those cases, the rationale of the opinions of the Ninth and Third Circuit Courts of Appeal, respectively, is the antithesis of the rationale of the Tenth Circuit Court of Appeals in this case. The Petition in No. 658 states that the Ninth Circuit Court of Appeals' decision "is in direct conflict" with the Tenth Circuit's decision in this case.

This Court has never laid down any criteria for testing the relationship between goods as concerns the likelihood of confusion as to source. In the 1925 term, the Court granted the writ in a case which presented the question, but the decision went off on other grounds (Beech-Nut Packing Co. v. P. Lorillard Co., 273 U.S. 625). Until this Court speaks on the subject and provides the lower Courts with some guide posts, confusion and conflict may be expected to continue whenever the lower Courts are confronted with a case in which a trademark owner prays for relief against the use of his mark on or in connection with goods or services specifically different from those upon which he had used the mark. The discord on the subject is illustrated by the following cases in which this Court was petitioned for the writ:

Petition Filed by Infringer:

National Dryer Manufacturing Corporation et al. v. The National Drying Machinery Company, 108 USPQ 54 (CA 3);

North American Aircoach Systems, Inc., et al. v. North American Aviation, Inc., 107 USPQ 68 (CA 9);

Pure Foods, Inc., v. Minute Maid Corp., 214 F. (2d) 792 (CA 5), Certiorari denied No. 392, 1954 Term;

Safeway Stores, Inc., v. Dunnell, 172 F. (2d) 649 (CA 9), Certiorari denied No. 686, 1948 Term;

Hanson et al. v. Triangle Publications, Inc., 163 F. (2d) 74 (CA 8), Certiorari denied No. 478, 1947 Term.

Petition Filed by Owner of Mark:

Hyde Park Clothes, Inc., v. Hyde Park Fashions, Inc., 204 F. (2d) 223 (CA 2), Certiorari denied No. 208, 1953 Term;

Sunbeam Lighting Co. et al. v. Sunbeam Corporation, 183 F. (2d) 969 (CA 9), Certiorari denied No. 428, 1950 Term;[4]

S. C. Johnson & Son, Inc., v. Johnson et al., 175 F. (2d) 176 (CA 2), Certiorari denied No. 294, 1949 Term;

Philco Corporation v. F. & B. Mfg. Co., 170 F. (2d) 958 (CA 7), Certiorari denied No. 596, 1948 Term.

As to the disparity between goods necessary to avoid likelihood of confusion as to source, the decision of the Court of Appeals in this case is in sharp conflict with the decisions of the Courts of Appeals in each of the above-tabulated cases where the Petition was filed by the infringer, and also with the decision in the Sunbeam case where the Petition was filed by the trademark owner; as well as Admiral Corp. v. Penco, Inc., 203 F. (2d) 517 (CA 2); Independent Nail & Packing Co., Inc., v. Stronghold Screw Products, Inc., 205 F. (2d) 921 (CA 7), and A. L. I. Restatement of the Law of Torts, Vol. III, §730, pp. 597, 598, §731.

That there has long existed a genuine need for clarification of the law on this subject by this Court is emphasized in an article by Lunsford which appeared in the Virginia Law Review in 1949, Volume 35, p. 214, entitled "Trade-Mark Infringement and Confusion of Source; Need for Supreme Court Action", wherein it is said at page 229:

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[4]In the Sunbeam case the Court of Appeals had granted relief against use of the mark on some uncompetitive goods, but the plaintiff thought the Court should have gone further.

"The confusion of the courts as to what constitutes confusion of source clearly demonstrates the need for a pronouncement by the Supreme Court. * * *

"Unless the Supreme Court acts, the owner of a trademark may get relief in the states of Arkansas, Missouri, Iowa, Minnesota, North and South Dakota and Nebraska, yet the infringer may use such celebrated trademarks as 'Sunkist' and 'Philco' with impunity in the States of Illinois, Wisconsin and Indiana.

"The Ninth Circuit, in conflict with the Seventh Circuit, confirmed the commentators' views in the very recent Stork Club case. The court cited with approval the Yale case and the Seventeen case and held that dilution of goodwill is a corollary to confusion of source. In granting the plaintiff an injunction against the defendant's use of 'Stork Club' as its trade name, the court concluded that appellant is not seeking to have appellees mulcted in damages, nor striving to drive them out of business, but merely asks appellee to desist from an unfair trade practice that threatens to dilute the value of its prestige. In contrast to Judge Minton's cry of monopoly[5], Judge Garrecht stated the complainant prayed not for a sword but for a shield."

II.

The Lower Court Either Closed Its Eyes to the Trade-Mark Act of 1946, or Held, in Effect, That the Trade-Mark Act of 1946 Does Not Mean What It Says. This Court Should Construe It.

The original opinion of the Court of Appeals treats the case as if the Trade-Mark Act of 1905 were still controlling. Until the opinion was amended after Petition for Rehearing,

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[5]Contra, Senate Report No. 1333, 79th Congress, 2nd Session, 3-4:

"Trade-marks defeat monopoly by stimulating competition."

it did not mention the Act of 1946[6], or the "likelihood" of confusion criterion laid down by that Act. The situation might suggest that the Court of Appeals was not aware of the 1946 Act at the time it reached its decision—but the briefs had been full of it. If the Court simply closed its eyes to the 1946 Act, it so far departed from the usual course of judicial proceedings that this Court should review the matter.

Regardless of whether the Court of Appeals closed its eyes to the 1946 Act initially, the amended opinion holds, in effect, that the remedial provisions of the Act of 1946 are limited by the standards of the 1905 Act. The holding that:

> "* * * the mere fact that one person has adopted and used a trade-mark on his goods does not prevent another from adopting and using the same mark on goods of a different description"[7]

will stand as a precedent for construction of the 1946 Act. But to so construe the 1946 Act overlooks the salient distinction between that Act and the Act of 1905. The 1905 Act restricted the protection of a registration to:

> "merchandise of the same descriptive properties"

while the 1946 Act extended such protection to all goods:

> "on or in connection with which such use (of the mark) is likely to cause confusion or mistake or to deceive purchasers as to the source of origin of such goods."

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[6]The original opinion erroneously stated that all nine of Petitioner's registrations were under the Act of 1905, whereas four of them are under the Act of 1946 as the amended opinion shows.

[7]This statement is borrowed verbatim from American Steel Foundries v. Robertson, 269 U. S. 372, 380, which was a suit against the Commissioner of Patents under the Trade-Mark Act of 1905.

This language seems plainly to eliminate the "descriptive properties" norm, but the Tenth Circuit and some other Courts continue to apply it. For instance, the Seventh Circuit Court of Appeals in Philco Corporation v. F. & B. Mfg. Co., 170 F. (2d) 958, gives lip service to the new Act on page 960:

> "* * * whether the goods are of similar character is not, under the present act, the determining factor (p. 960)

but on the very next page, the Court gets back into the "different description" rut of the 1905 Act.

On this point, the decision of the Court below is in direct conflict with the decision of the Fifth Circuit Court of Appeals in Pure Foods, Inc., v. Minute Maid Corp., 214 F. (2d) 792, where that Court ruled:

> "The remedies of an owner of a registered trademark, however, are not limited to the goods specified in the certificate but extend to any goods on which the use of an infringing mark 'is likely to cause confusion or mistake or to deceive purchasers as to the source of origin of such goods.' 15 U. S. C. A., § 1114(1). The Lanham Act thus adopts the principle stated in A. L. I. Restatement of the Law of Torts, Vol. III, § 730, pp. 597, 598, § 731" (p. 796).

as well as in conflict with the decision of the Second Circuit Court of Appeals in Admiral Corp. v. Penco, Inc., 203 F. (2d) 517.

The unfortunate situation is aptly described by Lunsford in the Virginia Law Review, supra, as follows:

> "The courts prior to the new Act were handicapped by the phrase 'goods of the same descriptive properties' in suits involving trademarks for dissimilar goods. The purpose of the Lanham Act was to remove this

handicap[8] and to broaden the scope of protection afforded a trademark owner. Thus it broadens trademark rights and remedies to include redress against the use of a colorable imitation which is 'likely to cause confusion or mistake.' It is a novation in judicial proceedings that a court will undertake to render impotent the express provisions of a law, the validity of which has not been questioned. Such action amounts to the shelving of legislative enactments, the application of which has heretofore been considered obligatory upon the courts in the absence of unconstitutionality" (p. 233).

This Court should construe § 32(1) of the Act of 1946 to set at rest the discordant views of the lower Courts as to whether the "different description" test is now properly applicable, or whether Congress intended that the confusion of source test be thenceforth applied[9].

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[8]The correctness of the commentators' statement of the purpose of the Lanham Act is demonstrated by the testimony of Edward S. Rogers during the hearings before the Sub-Committee on Trademarks of the House Committee on Patents with reference to H. R. 9041, 75th Congress, 3rd Session. Copy of page 52 of the report of such hearings is reproduced as Appendix F. While these hearings were held in connection with the original draft of the Lanham Act, they were the basis for subsequent bills, namely, H. R. 4744, 76th Congress; H. R. 6618, 76th Congress; S. 895, 77th Congress; H. R. 102, 77th Congress; H. R. 1424, 77th Congress; H. R. 82, 78th Congress; H. R. 1654, 79th Congress; which latter was passed.

[9]Callman, "Trade-Marks, Unfair Competition and the Courts: Some Unsettled Aspects of the Lanham Act", 66 Harvard Law Review, 1096, April, 1953.

III.

The Effect in a Civil Action of Previous Decisions of the Administrative Trademark Tribunal in an Adversary Proceeding Between the Same Parties Has Not Been, but Should Be, Settled by This Court.

While the decisions of this Court have firmly established the doctrine of "administrative finality" as regards the rulings of other administrative agencies of the Federal Government, this Court has never decided the effect of the rulings of the administrative agency vested by Congress with the authority to determine, in an adversary proceeding, whether there is conflict where the same trademark is applied to specifically different goods[10].

On this subject the Third Circuit (Century Distilling Co. v. Continental Distilling Co., 106 F. (2d) 486, 489) and the Ninth Circuit (Safeway Stores v. Dunnell, 172 F. (2d) 649, 652-3) have applied, in trademark cases, the doctrine of Morgan v. Daniels, 153 U. S. 120, to the effect that determinations of the Patent Office in inter partes proceedings concerning patents "must be accepted as controlling upon that question of fact in any subsequent suit between the same parties, unless the contrary is established by testimony which in character and amount carries thorough conviction."

The Second Circuit has said (Miles Shoes, Inc. v. R. H. Macy & Co., Inc., 199 F. (2d) 602, 603) that such rulings of the Patent Office are to be accorded "substantial weight", while the Seventh Circuit (Mantle Lamp Co. v. Aladdin Mfg. Co., 78 F. (2d) 426) has said "great weight."

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[10]In terms of the 1905 Act: goods of "the same descriptive properties".

In terms of the 1946 Act: goods such "as to be likely to cause confusion".

But in this case, the Tenth Circuit has given no weight at all to the administrative decision. While the opinion refers to the fact that the Patent Office denied registration to Respondent "on the ground that confusion might arise and that hunters might be led to believe that they were purchasing appellant's products," the Court completely ignores the fact that such a determination was made in an adversary proceeding between the parties to the present case. The only evidence pretended to overcome the administrative decision was the testimony of four witnesses that they did not know of any instance where any purchaser had been confused. As to the latter, the decision of the Tenth Circuit in this case is in direct conflict with the decision of the Ninth Circuit in Safeway Stores v. Dunnell, supra, where the Ninth Circuit Court held that such testimony was not sufficient to overcome the contrary ruling of the Patent Office.

Innumerable civil actions under the Trade-Mark Act of 1946 involve situations where there has been an antecedent administrative proceeding between the same parties, so that it is important that this Court make known its views for the guidance of the lower Courts with respect to the effect to be given such antecedent administrative decisions.

PRAYER.

Wherefore, your Petitioner respectfully prays that a Writ of Certiorari be issued to the United States Court of Appeals for the Tenth Circuit to the end that this cause may be reviewed and determined by this Court, that the decree of the Circuit Court of Appeals be reversed, and injunctive relief accorded Petitioner.

OLIN MATHIESON CHEMICAL CORPORATION,
By JOHN H. SUTHERLAND,
PHILIP B. POLSTER,
511 Locust Street,
St. Louis 1, Missouri,
Attorneys for Petitioner.

APPENDIX A.

Opinion of Court of Appeals As Amended After Petition for Rehearing.

(The italicized matter was introduced by amendment.)
(November 12, 1955)

John H. Sutherland (Charles H. Haines, Jr., John H. Bruninga and Philip B. Polster were with him on the brief) for Appellant;

Dudley Hutchinson (T. Henry Hutchinson and Dudley I. Hutchinson were with him on the brief) for Appellees.

Before PHILLIPS, Chief Judge, HUXMAN, United States Circuit Judge, and SAVAGE, United States District Judge.

HUXMAN, Circuit Judge.

Appellant, Olin Mathieson Chemical Corporation, filed an action in the United States District Court for the District of Colorado against appellee, the Western States Cutlery and Manufacturing Company, a corporation, et al., seeking an injunction restraining appellees from using the trade-mark "Western" and restraining them from selling or offering to sell knives bearing the trade-mark "Western" and for an accounting of profits realized from the alleged unlawful use of that trade-mark name upon knives sold. After a hearing before the court findings of fact and conclusions of law were made and based thereon judgment was entered dismissing appellant's complaint with prejudice.

Appellant, formerly operating under the name of Western Cartridge Company (a Delaware Corporation organized

January 25, 1922) and now operating under the name and style of Western Cartridge Company Division of Olin Industries, Inc., and appellant's predecessors have since January 1, 1896, been engaged in the manufacture and sale of ammunition, including shotshells, rifle and revolver cartridges, shotgun and air rifle shot, shot gun wads, bullets, shotgun and rifle powders, primers, blasting caps, targets and traps, at East Alton, Illinois, and at New Haven, Connecticut. Beginning January 1, 1896, appellant's predecessors adopted "Western" as their trade-mark for such products and continuously since appellant and its predecessors have manufactured, sold and distributed large quantities of such products bearing the trade-mark "Western" throughout the United States and in foreign countries, primarily to hunters and sportsmen. Such sales have been made through hardware stores, sporting goods stores and other similar retail outlets.

Appellant is the owner of nine registered trade-marks of the mark "Western." *The first five were** registered pursuant to the Trade-Mark Act of February 20, 1905, *and the last four were registered under the Act of 1946.** Four of these registrations registered the word "Western" in script enclosed in a diamond format. The other five merely registered the word "Western" in script, varying somewhat in the characters employed.

Appellee, the Western States Cutlery and Manufacturing Company, organized under the laws of the State of Colorado in 1913, began the selling of cutlery as a jobbing business shortly thereafter. It and its predecessors have been continuously engaged in such business from that time on. As early as 1920 appellee and its predecessors

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*The italicized matter was introduced by amendment after Petition for Rehearing.

began the manufacture of cutlery, including pocket knives. Beginning at least by the early 1930's they began the manufacture and sale of hunting or outdoor knives on which the word "WESTERN" alone or in combination was stamped. Sometimes the word "WESTERN" alone was used. At other times "WESTERN Boulder Colorado" was stamped on the knives with Boulder Colorado printed in smaller type. Some were stamped "Western States," some with "West-Cut," some with other marks and some with no marks at all.

In the early 1930's the hunting knife production constituted about ten per cent of the business of appellee and its predecessors. Since then there has been a steady increase in the manufacture and sale of these hunting knives and later of axes, until at the present time such products constitute over seventy-five per cent of appellee's production.

Since 1918 appellees have employed the practice of issuing catalogues disclosing its cutlery stamped as above indicated, and beginning in July, 1944, its hunting knives and other cutlery products, including knives manufactured for the war effort for the Government, were advertised in national magazines such as Outdoor Life, Field and Stream and Sports Field. Included in some of these issues were advertisements by appellant.

In 1931 appellant purchased the assets of the Winchester Repeating Arms Company of New Haven, Connecticut, and among the assets was a line of cutlery including pocket knives and hunting knives. Appellant continued to sell such knives and cutlery until 1940, when it withdrew from the cutlery business. At all times while it was selling such products they were sold under the name "Winchester."

On January 25, 1932, appellee filed in the United States Patent Office an application for the registration of the word "Western" as a trade-mark for hunting knives, pocket knives and outing knives. The application was denied on the ground that confusion might arise and that hunters might be led to believe that they were purchasing appellant's products.

Since appellant is not manufacturing and selling cutlery or knives of any kind, there is no competition between it and appellees; and it is obvious, as found by the court, that the sale of knives and cutlery by appellees has not deprived appellant of sales of knives or of cutlery.

These principles of law must be kept in mind in resolving the controversy presented by this appeal. The law of trade-marks and trade-mark infringement is but a part of the law of unfair competition.[1] So also the mere fact that one person has adopted and used a trade-mark on his goods does not prevent another from adopting and using the same mark on goods of a different description.[2] Further, the right to a trade-mark grows out of the use and not out of the adoption of a trade-mark.[3] One other principle need be kept in mind. The law differentiates between distinctive and fanciful marks or names and general names or words in common use. The first class of words or names will be broadly protected, but the latter class will receive a much narrower protection.[4]

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[1]Hanover Milling Co. v. Metcalf, 240 U. S. 403; Brown & Bigelow v. B. B. Pen Co., 191 F. 2d 939; Seven Up Co. v. Cheer Up Sales Co., 148 F. 2d 909.

[2]Philco Corp. v. F. & B. Mfg. Co., 170 F. 2d 958, and cases there cited; Menihon v. Pachmayr, 220 F. 2d 879.

[3]Hanover Milling Co. v. Metcalf, 240 U. S. 403.

[4]American Steel Foundries v. Robertson, 269 U. S. 372; Sunbeam Furniture Corp. v. Sunbeam Corp., 191 F. 2d 141; Majestic Mfg. Co. v. Majestic Elec. Appliance Co., 172 F. 2d 862; Sunbeam Lighting Co. v. Sunbeam Corp., 183 F. 2d 969; Dwinell-Wright Co. v. National Fruit Product Co., 140 F. 2d 618.

Tested by these principles we are of the view that the decision of the trial court is correct. "Western" is a common word which is in general use. There are any number of enterprises which employ this word in describing their business. It follows, therefore, that the word "Western" in appellant's trade-mark receives a narrow construction and the protection accorded appellant is narrowly construed.

It is doubtful if appellant's business, as described in its application for its trade-marks, is sufficiently comprehensive to include hunting knives within the narrow protection to which its trade-mark is entitled. The nature of its business in the nine applications for its trade-marks is variously described as "shotshells, gun-wads, cartridges, shot, smokeless and semismokeless powder for ordnance and small-arm ammunition, primers, and blastingcaps, in Class 9 Explosives, firearms, equipments, projectiles, rifle cartridges, pistol cartridges, targets and target traps in Class 22." In three of its applications it described the trade-mark as being for "targets and target traps in Class 22, Games, toys and sporting goods."[3]

It is our view that under the narrow construction which must be adopted in this case there are no appropriate descriptive words which would bring cutlery, pocket knives and hunting knives under the protection of the trade-mark "Western". The only words relating even remotely to hunting knives are the words "sporting goods." That phrase again is one of broad meaning. If it is sufficiently definite to apply to hunting knives, why would it not also apply to hunting caps, coats, trousers, shoes, socks, shirts, compasses, camp cook stoves, cooking kits, as well as hundreds of other articles sportsmen use. Such a construction

[3]Emphasis supplied.

would tend to give appellant a monopoly of the trade-mark "Western" on practically everything that is made to be sold to sportsmen.

Furthermore, appellant is not now and never has been engaged in selling hunting knives under its registered trade-mark and as is pointed out in the principles of law hereinbefore stated the right to the protection of the trade-mark grows out of the use and not out of the adoption of the mark. Not having used the trade-mark with respect to hunting knives, it cannot complain because appellant uses the common word "Western" on the cutlery which it sells, even though it should be held that the term "sporting goods" is sufficiently definite to include hunting knives.

What has been said would not, however, warrant appellee in panning off its knives as a product of appellant or selling its products under such conditions that there would be confusion in the minds of the purchasing public with respect to whether they were purchasing appellant's products or the products of some other company. Such conduct would constitute unfair trade competition.

There is no evidence in the record warranting a statement that appellee is attempting to deceive the public into believing that knives which are stamped "Western" by it are the product of the appellant. There is no evidence that a single purchaser of a hunting knife was misled or deceived into believing that a knife purchased by him stamped "Western" was a product of appellant. Appellant made some effort to establish that confusion would result. This was done by offering the testimony of some paid investigators who went into stores which handled appellant's trade-marked products and also appellee's knives. They usually began by handing the clerk a list of objects sought. This list would contain an item of a box of Western shells and then a request for a knife made by Western Cartridge

Company. Obviously, the store had no such knife. Sometimes the clerk would so state and at other times the clerk would get out a knife marked with appellee's trade-name and hand it to the investigator with the statement that it was a good knife and that it was made by Western Cartridge Company. We agree with the trial court that this evidence under the circumstances was not sufficient to establish *the likelihood of** confusion in the minds of the buying public.

AFFIRMED.

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*The italicized matter was introduced by amendment after Petition for Rehearing.

APPENDIX B.

Opinion of District Court.

The Court: As this case has gone on, the Court has formed some impressions about the facts, and also in the course of the case by reason of the Court's natural interest in the proceeding and also because of the questions that have come up with respect to the admissibility of evidence and have examined a number of authorities and textbooks in this field a number of which have been referred to by counsel here in their arguments.

I recognized at the beginning of the case counsel on both sides had had more experience in this particular field than has been my privilege. For that reason I probably have broadened the scope of admissibility of evidence, particularly documentary evidence and other matters with the idea that everyone would be permitted to develop their theory to the fullest degree.

So, as a result I came to the point of argument, as I say, with impressions with respect to the case, and since hearing the argument and since considering the evidence the Court has given thought and consideration on this subject during the course of the trial and before, and I believe I have reached a conclusion which would not be changed by a further consideration of the case. Very likely the evidence and arguments are more freshly in my mind and counsel's mind than it will be at a later date, and, so, I have concluded to announce my views on the case at this time.

I have made some notes about the law as I have gone along, and seemingly the law is not greatly in dispute be-

tween counsel. As I understand, the right to the exclusive use of a trade mark is limited to a use of it upon some particular class of goods. Accordingly, it is not an infringement for another person to use even the same identical trade mark on a different class of goods from that which the prior user applied even to the extent of preventing the prior user with the mark subsequently enlarging his use to include the same class to which the second user has affixed his mark, which, of course, is not the situation here.

Goods are in the same class within this rule whenever the use of a given trade-mark name or symbol would enable an unscrupulous dealer to palm off on unsuspecting customers spurious goods as being the genuine goods of the proprietor of the trade mark even though there is a difference in the size and form of the receptable, and so forth, and whenever the goods are in some manner so intimately connected with the trade as to make not unreasonable a belief on the part of the purchasers that the same company was manufacturing or selling both. That last statement, I think, is particularly pertinent to the phase of the law that applies in this case. Of course, the statue now which I think is not greatly changed from what the majority of the courts held before prescribes a test, a likelihood of causing confusion or to deceive the purchaser with respect to the trade mark infringement.

In the field of unfair competition there is, as the name implies, the very word "competition" implied, as a condition of unfair competition some sort of a competition between the products or the concerns which are involved in the litigation. I think Corpus Juris said the doctrine is usually invoked where there is an actual mark of competition between the analogous products of plaintiff and defendant, and so it has been natural enough to speak of

it as the doctrine of unfair competition, and it has been held there must be actual competition before there can be any unfair competition. There cannot be competition unless there is something to compete with.

Now, considering those basic principles also the further legal proposition I think is stated in Corpus Juris or American Jurisprudence—I don't know which it is—the courts have generally held that the doctrine of unfair competition is not confined to cases of actual market competition between similar products of the parties but that it extends to all cases in which one party fraudulently seeks to sell his goods as those of another. It does not necessarily involve unfair competition in the sale of goods but it is an unfair appropriation and use of competitor's market with the intention to profit in the sale of goods of that character.

I think those basic principles of law apply, and, of course, there are some rules that might be said to have been established by the precedents with respect to certain phases of the matter which permits the Court to reach certain conclusions with respect to these basic matters. As I understand the evidence here and appraise it, the Western Cartridge Company, one of the best known concerns in its field in the United States, itself, had a rather long existence. Its products consist, as I understand, of cartridges for small arms, guns, rifles, revolvers, the component parts for ammunition, bullets, cartridge cases, powders, and also have extended into a line of traps for projecting clay pigeons or targets. Likewise, it is engaged in some sort of sheet metal operation in brass and possibly other associated metals, and in some fields of explosives beyond that area.

By reason of its long and honorable career in this field it has established a place in the minds of those who use

ammunition, who shoot guns, and are engaged in that particular operation and perhaps in the other field also of sheet metal and of explosives although it has not been developed so extensively here, and they have attained a place where its name is said to have even a secondary meaning.

The great bulk of the plaintiff's evidence, it seems to me, was devoted to establishing what I would think from the pre-trial conferences and the general position of the parties was almost an admitted fact that in these fields that I have indicated, that is, in the fields of ammunition, the field of component parts of ammunition, in the traps for the projectile on targets and the like that the term "Western" has become so well known that it has come to mean to sportsmen, to the users of goods in the field, the Western Cartridge Company. In fact, a great deal of the written matter that has been introduced here especially by what might be called professional writers generally refers, I might say, to the products of this company in that particular field as "Western". So that to that extent there is no question in the Court's mind that "Western" has become a common designation for plaintiff's products.

If the product of defendants here came within that field, of course, for instance, to make it clear, the manufacture of primers or something associated with ammunition or of the other products of Western Cartridge Company, of course, that could not be permitted under the law. The Western Cartridge Company, the evidence further shows, has registered a number of trade marks. I think it is nine, but I am not sure, but a considerable number. Some of them have the word "Western" in script, and some have it in block or other type letters. I think from observation of the Exhibits which have been introduced in evidence here that generally they appear in the form

of script. However, as the Court views the trade marks there is nothing particularly distinctive about the form of the use that is said to be involved in this infringement because of the type of stamp the defendants use. It is quite true that on some of the advertising of the defendants the word "Western" in the form of the imitation of a coiled rope to spell the word "Western" appears, and I think in comparatively recent advertising matter, but the word "Western" is not distinctive or is not a coined word in the sense of "Kodak" or "Frigidaire" or some of these other words that have been mentioned by counsel in arguments, and there is nothing I think distinctive in the type or in the form of the trade mark as would be the case if there was something of the sort that plays an important a part in the trade mark as does the written matter.

So, I think the question on that basis simmers down to whether the use of the word "Western" as a word on the products of the defendants could constitute an infringement or unfair competition.

The defendant company, the evidence shows, has been in existence for a considerable time, since the early part of 1900. I don't recall the exact date, 1917 or something like that, I guess before that, but I don't think it is important. It had its inception originally as more or less of a sales venture in which the original organizers operated as jobbers in the field of general cutlery. As they progressed, of course, they first buffed some of the knives they bought elsewhere and then eventually became involved in manufacturing until presently they are in full-fledged manufacturing operations. The name according to the testimony, the Western States Cutlery and Manufacturing Company, which is the corporate name of the defendant, appears to have been selected by the family after several family conferences, and I am certain from the evidence

at that time there was no notion or no connection formed in any of their minds between that name and the Western Cartridge Company. I don't know there is any evidence at that time any of them even knew of the existence of the Western Cartridge Company.

Be that as it may the matter went on until and during this time, as I say, there were several kinds of knives produced. For a while even after they were in the manufacturing field they continued to job knives including the Marble knife which I think the evidence shows was a very well known knife in the outing and hunting field. Eventually the products became substantially all produced and manufactured by the company.

As they proceeded along they used apparently several ways of marking knives. There has been a lot of evidence here pro and con with respect to when they first started marking their knives "Western". Much of it depended upon the recollection of witnesses and the form of association with other items. But as I see the case, that particular fixing of that particular date is not extremely important. I think it is obvious from the evidence that at some point probably in the early thirties or along about that time, and, as I say, I don't think that is too important — I don't know that I am fixing that date from the evidence —that it started to use the word "Western". Sometimes it was used alone. Other times, more recently, apparently, it has been used in connection with "Western, Boulder, Colorado", printed in smaller type on the tang, I think you called it, on the face of the blade of the knife. On other knives a different name "West-Cut" was used. The Court can understand the transition period that involved the use and change in these names.

In that connection one thing that has been mentioned and I think one thing that the Court in a number of cases

has mentioned is the fact that there has not been a single bit of evidence here or a single witness testify or a single scrap of evidence so far as I know that indicates that any time during all these years anyone has been confused or deceived, any customer, consumer, put it that way, has been deceived or confused by this brand. Now, I know there are cases that hold there is no necessity, as a matter of fact, of showing that in some instances to entitle the trade-mark owner to injunctive relif, but I think all the courts say that is the strongest line of evidence to adduce to establish the fact that there is confusion or that there is a deception to the customer, and, as has been pointed out, I think that is the test, I mean the level of the test in that connection.

It would seem whether this "Western" was first marked on in 1930 or '27 or '44 or any other time that over that period of years that there would come to the defendants' or to the plaintiff's attention if the fact was that there was actual confusion or deception in some manner, that it would be called to their attention. But so far as that appears from the evidence in that particular there is no evidence whatever. There is a lot of negative evidence here from people who have handled a considerable number of defendants' products that they have never heard of anyone claiming they were confused or deceived by the use of this name "Western" on these knives or led to believe by that through confusion that they were the products of the Western Cartridge Company which, of course, has been claimed by the plaintiff in this particular case.

Now, we have here, of course, as has been commented on by counsel, what I think the courts have referred to as trap sales, the sales which originally are through this representative of some investigating agency at the instance of the manufacturer going to various stores and

purchasing knives. The usual practice was to hand the clerk a slip requesting a box of ammunition designated as being produced by the Western Cartridge Company and then also a knife manufactured by the Western Cartridge Company. Of course, the evidence in the Court's mind is not entitled to very much weight right from the beginning because the individual knew that Western Cartridge Company did not make a knife, never had made a hunting knife or knife so far as I know or cutlery of any sort whatsoever. Of course, I also know, as counsel will probably recall, that there are some cases that hold that it is immaterial whether the actual purchaser was deceived or not. The test is whether the purchasing public is likely to be deceived because of confusion by the use of the name.

But, nevertheless, in judging the weight to be given that evidence I think that factor is a consideration. Now, I would assume in appraising that evidence, from hearing what the witness testified to with respect to the responses given by the various sales clerks in these various establishments where he did succeed in purchasing the knife, of course, from the very fact that such a thing as selling a knife made by the Western Cartridge Company was clear out of a consideration, he ended up with the knife branded "Western", produced by the Western States Cutlery and Manufacturing Company. I think as a matter of common experience that a saleswoman or salesman in those circumstances where the customer made that request might consider that the customer was mistaken in his designation of the manufacture of the knife and that the obligation of the clerk to his employer was to complete a sale and that probably the Western knife was handed out with that in view, and I think that would be the natural consequences.

Further, I was struck by this: that in a number of those instances which I would not attempt to say how many, the

purchaser, of course, knew full well and as was mentioned in the conversation, in the inference or otherwise that the knife purchased and selected by him was a Western knife produced by the Western Cutlery Company.

So that particular evidence to the Court is not very convincing even as to the possibilities of deception and confusion from the sale of these products. There has been some evidence introduced I think that at one time Winchester, which is now one of the large concerns which has been acquired by the plaintiff, had manufactured hunting knives. That was discontinued a number of years ago, and, of course, during that period both Western and Winchester being under the management of Olin, there was some contact with this Cutlery Association to which they both belonged and from which association possibly the knowledge of products of others could be obtained and things of that sort. As I see it, it is not decisive one way or the other in this case, and the time element I think is considerable.

I don't think there is any question of laches or anything like that chargeable against the plaintiff, but I think that that expression of time is a factor in determining whether there is a likelihood here of confusion or anything that would deceive the public through the use of this name. As I pointed out a moment ago, if during these many, many years without specifying how many, but in anyone's figure in a very considerable period even if it is taken down to the 1940 dates or 1937 date, I think they have been mentioned, would indicate to the Court that there hasn't actually been any confusion or deception to the consuming public by reason of this use of the name. I don't think it is necessary although probably the situation could be fitted into the pattern or the theories of the Arrow case and of this Gold Medal case. I don't think we have to get into those refine-

ments. It seems to me that the products are so distinct that there is no competition between the products or between the companies with respect to these particular things, the things that Western States Cutlery and Manufacturing Company manufactures and the things that Western manufactures and sells, and also I don't think on the theory of "Western" that its trade name and reputation, so to speak, per se must be held inviolate, I don't think there is anything in the relationship that shows an infringement violation on that basis.

Now, the only thing, as I say, in the whole case that has raised some apprehension in the Court's mind is that finding in the Patent Office in that opposition proceeding when Western in 1932 sought to register the name "Western" and the opposition by the Western Cartridge Company was sustained. I have read that record. It has been introduced here in evidence, and the reasoning of the patent office was that, since the hunting knife was a thing that would be purchased by a hunter or an outdoorsman—I don't recall the exact words—therefore, the fact it was hunters equipment brought it into the field of the products of the Western Cartridge Company.

I don't agree with that reasoning. I feel, if that sort of reasoning were made the test, that you would have to extend the thing into the fields that would make the rule ridiculous and obviously the one that in a great many cases have been recognized such as the Arrow case and Gold Medal case, cases of that type, because a hunter naturally in addition to a gun or ammunition will have possibly a hunting knife but not nearly with the certainty that he would have garments or food of some sort, shirts of some make. If the doctrine is extended to anything in the protection of this trade name "Western", considering the products of that company, anything a hunter wears or uses,

if that criterion is used, yet get into the field of the ridiculous, because I don't think that counsel would claim there could be any extension of that sort. So, I think the reasoning by which the patent office arrived at the disposition of this opposition is not sound.

I know it is entitled to weight because of their experience, but I think on the face of it that the reasoning was possibly not considered.

Another thing that emphasizes or illustrates properly the Court's view in this case is this episode of the Redfield Site Company. Now, that concern manufactures gun sites, manufactures mountings for telescopes. It is associated right in the very field, it seems to me very near the actual business of the Western Cartridge Company, and I think, for instance, by way of illustration had Redfield kept the name "Western", and they had established as they have in their own name now a very high reputation I think nation wide probably with respect to their sites, I don't believe they could complain of the operations of the defendant considering the products it makes and sells in its cutlery line.

So, basically, gentlemen, that represents the Court's view on the case. I think the defendants can prepare findings of fact. I haven't attempted to make it inclusive, but it does substantially reflect my view of why I find in favor of the defendants and against the plaintiff. You can prepare findings and submit them to counsel in due course, and, if they cannot be agreed upon as to form, you can set it down for settlement. If you cannot agree as to form by stipulation, they can be set down for settlement.

APPENDIX C.

Opinion of Patent Office.

This is an opposition in which both parties have filed briefs but only the opposer has filed testimony or was represented at the final hearing.

The request filed April 17, 1933, by the opposer to dispense with the printing of its testimony is approved.

The applicant is here seeking to register the notation "WESTERN" for hunting knives, pocket knives and outing knives.

The opposer relies upon the name and the confusion-in-trade clauses of section 5 to negative the right of registration of the applicant, and alleges use as a name, of the notation Western Cartridge Company, and as a trademark, of the notation "WESTERN" in connection with ammunition, including shot shells, gun wads, cartridges, powder, primers and blasting caps, targets and traps, as appears from Registrations 142,347; 149,543; 210,699 and 224,874, ownership of which is pleaded in the notice of opposition.

As to the ground based on the name clause it seems fairly clear to the examiner that use by the opposer of the name Western Cartridge Company does not negative the right of registration of the notation "WESTERN" of the applicant.

American steel Foundries v. Robertson, Commissioner of Patents and Simplex Electric Heating Company, 342 O. G. 711; 1926 C. D. 289; 269 U. S. 372;

Three In One Oil Co. v. Lobel Mfg. Co., 368 O. G. 3; 1928 C. D. 72; 23 F. (2d) 893;

Eureka Vacuum Cleaner Co. v. Eureka Sales Co., 151 Ms. D. 835.

The ground based on the confusion-in-trade clause will now be considered.

Both parties use as their marks, the notation "WESTERN." The marks are therefore substantially the same and the opposer being the prior user for a great many years, there remains for determination therefore only the quesiton of descriptive properties of the goods.

There is considerable force to applicant's contention that two products do not necessarily possess the same descriptive properties merely because they are sold from the same stores. The goods here under consideration, however, have in common more than just this feature alone. It is a matter of common knowledge that a knife of some sort, be it a hunting knife, or a pocket knife, or one known by some other name, is as much a part of a hunters equipment as is a gun, cartridges, shells or powder. In view of this close association of these articles in use, as well as the fact that they are also handled by the same stores, and in some instances, as the record shows, are made and sold by the same manufacturers, it is believed that they belong to the same general class of merchandise and consequently possess the same descriptive properties within the meaning of the statute. It is so ruled.

Cheek-Neal Coffee Company (Maxwell House Products Co. Inc., substituted) v. Hal Dick Manufacturing Company, 395 O. G. 10; 40 F. (2d) 106; 1930 C. D. 251;

Revere Sugar Refinery v. Salvato, 18 C. C. P. A. ____; 409 O. G. 562;

Harlan Wallins Coal Corp. v. Transcontinental Oil Co. (The Ohio Oil Company, assignee substituted) Decided April 17, 1933, C. C. P. A. not yet published.

Accordingly, the opposition is sustained and it is adjudged that the applicant is not entitled to the registration for which it has made application.

Limit of appeal July 6, 1933.

/s/ J. Carnes
Examiner of Interferences,
Room 3088.

June 6, 1933.

APPENDIX D.

Trade Mark Act of 1946.

Sections 2, 32 (1), 46 (b).

Sec. 2. Trade-marks registrable on the Principal Register

No trade-mark by which the goods of the applicant may be distinguished from the goods of others shall be refused registration on the principal register on account of its nature unless it—

(a) Consists of or comprises immoral, deceptive, or scandalous matter; or matter which may disparage or falsely suggest a connection with persons, living or dead, institutions, beliefs, or national symbols, or bring them into contempt, or disrepute.

(b) Consists of or comprises the flag or coat of arms or other insignia of the United States, or of any State or municipality, or of any foreign nation, or any simulation thereof.

(c) Consists of or comprises a name, portrait, or signature identifying a particular living individual except by his written consent, or the name, signature, or portrait of a deceased President of the United States during the life of his widow, if any, except by the written consent of the widow.

(d) Consists of or comprises a mark which so resembles a mark registered in the Patent Office or a mark or trade name previously used in the United States by another and not abandoned, as to be likely, when applied to the goods of the applicant, to cause confusion or mistake or to deceive purchasers: *Provided*, That the Commissioner may

register as concurrent registrations the same or similar marks to more than one registrant when they have become entitled to use such marks as a result of their concurrent lawful use thereof in commerce prior to any of the filing dates of the applications involved and the Commissioner or a court on appeal determines that confusion or mistake or deceit of purchasers is not likely to result from the continued use of said marks under conditions and limitations as to the mode or place of use or the goods in connection with which such registrations may be granted which conditions and limitations shall be prescribed in the grant of the concurrent registrations thereof; and concurrent registrations may be similarly granted by the Commissioner with such conditions and limitations when a court has finally determined that more than one person is entitled to use the same or similar marks in commerce. The Commissioner shall give not less than thirty days written notice to all applicants, registrants, and users specified by any of the parties concerned of any application for concurrent registration and of the time and place of the hearings thereon. When the Commissioner decides to grant a concurrent registration the proposed registration shall be published in the Official Gazette of the Patent Office and the application shall be subject to opposition as hereinafter provided for other applications to register marks. Concurrent registrations may be ordered by a court in an action under the provisions of section 4915, Revised Statutes, under such conditions and limitations as the court considers proper in accordance herewith.

(e) Consists of a mark which, (1) when applied to the goods of the applicant is merely descriptive or deceptively misdescriptive of them, or (2) when applied to the goods of the applicant is primarily geographically descriptive or deceptively misdescriptive of them, except as indications

of regional origin may be registrable under section 4 hereof, or (3) is primarily merely a surname.

(f) Except as expressly excluded in paragraphs (a), (b), (c), and (d) of this section, nothing herein shall prevent the registration of a mark used by the applicant which has become distinctive of the applicant's goods in commerce. The Commissioner may accept as prima facie evidence that the mark has become distinctive, as applied to the applicant's goods in commerce, proof of substantially exclusive and continuous use thereof as a mark by the applicant in commerce for the five years next preceding the date of the filing of the application for its registration. (15 U. S. C. 1052)

Sec. 32 (1). Remedies—Infringement

Any person who shall, in commerce, (a) use, without the consent of the registrant, any reproduction, counterfeit, copy, or colorable imitation of any registered mark in connection with the sale, offering for sale, or advertising of any goods or services on or in connection with which such use is likely to cause confusion or mistake or to deceive purchasers as to the source of origin of such goods or services; or (b) reproduce, counterfeit, copy, or colorably imitate any such mark and apply such reproduction, counterfeit, copy, or colorable imitation to labels, signs, prints, packages, wrappers, receptacles, or advertisements intended to be used upon or in connection with the sale in commerce of such goods or services, shall be liable to a civil action by the registrant for any or all of the remedies hereinafter provided, except that under subsection (b) hereof the registrant shall not be entitled to recover profits or damages unless the acts have been committed with knowledge that such mark is intended to be used to cause confusion or mistake or to deceive purchasers. (15 U. S. C. 1114 (1))

Sec. 46 (b). Existing registrations under prior acts

Acts of 1881 and 1905. Registrations now existing under the Act of March 3, 1881, or the Act of February 20, 1905, shall continue in full force and effect for the unexpired terms thereof and may be renewed under the provisions of section 9 of this Act. Such registrations and the renewals thereof shall be subject to and shall be entitled to the benefits of the provisions of this Act to the same extent and with the same force and effect as though registered on the principal register established by this Act except as limited in sections 8, 12, 14, and 15 of this Act. Marks registered under the "ten-year proviso" of section 5 of the Act of February 20, 1905, as amended, shall be deemed to have become distinctive of the registrant's goods in commerce under paragraph (f) of section 2 of this Act and may be renewed under section 9 hereof as marks coming within said paragraph.

Act of 1920. Registrations now existing under the Act of March 19, 1920, shall expire six months after the effective date of this Act, or twenty years from the dates of their registrations, whichever date is later. Such registrations shall be subject to and entitled to the benefits of the provisions of this Act relating to marks registered on the supplemental register established by this Act, and may not be renewed unless renewal is required to support foreign registrations. In that event renewal may be effected on the supplemental register under the provisions of section 9 of this Act.

Subject to registration under this Act. Marks registered under previous Acts may, if eligible, also be registered under this Act. (15 U. S. C. 1051 note)

APPENDIX E.

Trade Mark Act of 1905.

Sections 5 and 16.

SEC. 5. U. S. C., title 15, sec. 85. That no mark by which the goods of the owner of the mark may be distinguished from other goods of the same class shall be refused registration as a trade-mark on account of the nature of such mark unless such mark—

(*a*) Consists of or comprises immoral or scandalous matter.

(*b*) Consists of or comprises the flag or coat of arms or other insignia of the United States or any simulation thereof, or of any State or municipality or of any foreign nation, or of any design or picture that has been or may hereafter be adopted by any fraternal society as its emblem, *or of any name, distinguishing mark, character, emblem, colors, flag, or banner adopted by any institution, organization, club, or society which was incorporated in any State in the United States prior to the date of the adoption and use by the applicant: Provided, That said name, distinguishing mark, character, emblem, colors, flag, or banner was adopted and publicly used by said institution, organization, club, or society prior to the date of adoption and use by the applicant: Provided,* That trade-marks which are identical with a registered or known trade-mark owned and in use by another and appropriated to merchandise of the same descriptive properties, or which so nearly resemble a registered or known trade-mark owned and in use by another and appropriated to merchandise of the

As amended by act of Jan. 8, 1913.

same descriptive properties as to be likely to cause confusion or mistake in the mind of the public or to deceive purchasers shall not be registered: *Provided*, That no mark which consists merely in the name of an individual, firm, corporation, or association not written, printed, impressed, or woven in some particular or distinctive manner, or in association with a portrait of the individual, or merely in words or devices which are descriptive of the goods with which they are used, or of the character or quality of such goods, or merely a geographical name or term, shall be registered under the terms of this Act: *Provided further*, That, no portrait of a living individual may be registered as a trade-mark except by the consent of such individual, evidenced by an instrument in writing, nor may the portrait of any deceased President of the United States be registered during the life of his widow, if any, except by the consent of the widow evidenced in such manner: *And provided further*, That nothing herein shall prevent the registration of any mark used by the applicant or his predecessors, or by those from whom title to the mark is derived, in commerce with foreign nations or among the several States or with Indian tribes which was in actual and exclusive use as a trade-mark of the applicant, or his predecessors from whom he derived title, for ten years next preceding February twentieth, nineteen hundred and five: *Provided further*, That nothing herein shall prevent the registration of a trade-mark otherwise registerable because of its being the name of the applicant or a portion thereof.

As amended by act of Mar. 19, 1920.

And if any person or corporation shall have so registered a mark upon the ground of said use for ten years preceding February 20, 1905, as to certain articles or classes of articles to which said mark shall have been applied for said period, and shall have thereafter and subsequently ex-

tended his business so as to include other articles not manufactured by said applicant for ten years next preceding February 20, 1905, nothing herein shall prevent the registration of said trade-mark in the additional classes to which said new additional articles manufactured by said person or corporation shall apply, after said trade-mark has been used on said article in interstate or foreign commerce or with the Indian tribes for at least one year provided another person or corporation has not adopted and used previously to its adoption and use by the proposed registrant, and for more than one year such trade-mark or one so similar as to be likely to deceive in such additional class or classes.

SEC. 16. U. S. C., title 15, sec. 96. That the registration of a trade-mark under the provisions of this act shall be prima facie evidence of ownership. Any person who shall, without the consent of the owner thereof, reproduce, counterfeit, copy, or colorably imitate any such trade-mark and affix the same to merchandise of substantially the same descriptive properties as those set forth in the registration, or to labels, signs, prints, packages, wrappers, or receptacles intended to be used upon or in connection with the sale of merchandise of substantially the same descriptive properties as those set forth in such registration, and shall use, or shall have used, such reproduction, counterfeit, copy, or colorable imitation in commerce among the several States, or with a foreign nation, or with the Indian tribes, shall be liable to an action for damages therefor at the suit of the owner thereof; and whenever in any such action a verdict is rendered for the plaintiff, the court may enter judgment therein for any sum above the amount found by the verdict as the actual damages, according to the circumstances of the case, not exceeding three times the amount of such verdict, together with the costs.

APPENDIX F.

Page 52—Hearings Before Sub-Committee on Trademarks of House Committee on Patents March 16, 1938— Re H. R. 9041.

MR. LANHAM. We will let him conclude his statement, and then we will hear from you.

MR. ROGERS. The second paragraph of the sentence covers the use of the goods, and there is a change in existing law in that connection. Existing law prohibits the use of deceptive similar trade-marks on goods—now, may I particularly call your attention to this language—of substantially the same descriptive properties of the goods mentioned in the certificate of registration.

Now the phrase "goods of substantially the same descriptive properties" must have been evolved by a virtuoso in vagueness. It occurs nowhere that I know of except in our Federal trade-mark statute, and it has been the result of an enormous amount of litigation, and the courts have swung one way and the other. First they held that the goods were of the same descriptive properties if they had the same physical characteristics. Following that theory, they held that oil paint and kalsomine, one being mixed with oil and the other with water, were goods of different descriptive properties and the same trade-mark could be used on both. Then they saw that that construction was absurd and they enlarged the rule and held that goods were of the same descriptive properties if the use of the same trade-mark upon them suggested to the ordinary consumer a common article, so that necessarily overruled the opinion in the kalsomine case, because a man buying the Dutch Boy brand of kalso-

mine would necessarily naturally assume it came from the same manufacturer that made Dutch Boy paint.

Recently, the courts have gone even further and they have held that goods are of the same descriptive properties if they fit into a recognized trade class, and they have gone to the extent of holding that groceries, for example, olive oil, on the one hand, and coffee, on the other, are goods of the same descriptive properties and, incidentally, they always have, and the present law is that goods are the same in legal contemplation if the use of the same mark on the two varieties would suggest to the consumer that they come from the same place, or were made by the same concern. That is the present law.

That seems to all of us to be a sensible interpretation and we have scrupulously avoided the use of this "bugbear" phraseology, "goods of the same descriptive properties," and have tried to put it in this way, as shown on the top of page 2—

> merchandise of such a character that the use of the copy, counterfeit, or colorable imitation in connection therewith is likely to cause confusion or mistake or to deceive purchasers.

That is the present law as laid down by the decisions. It is a departure from the language of the present statute.

APPENDIX G.

Judgment of the Court of Appeals.
Judgment.

Thirty-seventh Day, September Term, Saturday, November 12th, 1955.

Before Honorable Orie L. Phillips, Chief Judge, Honorable Walter A. Huxman, Circuit Judge, and Honorable Royce H. Savage, District Judge.

This cause came on to be heard on the transcript of the record from the United States District Court for the District of Colorado and was argued by counsel.

On consideration whereof, it is ordered and adjudged by this court that the judgment of the said district court in this cause be and the same is hereby affirmed.

APPENDIX H.

Judgment of the District Court.

56) **Final Judgment.**

This Cause having come on for hearing before the Court on February 1, 2, 3, 4 and 5, 1954, and the Court having considered the evidence adduced, and heard the arguments of counsel for the respective parties, and having this day made and entered its Findings of Fact and Conclusions of Law,

It Is Hereby Ordered, Adjudged and Decreed:

1. That the Complaint herein be and it is hereby dismissed with prejudice.

2. That Defendants' Counterclaims as expressed in prayers 2 and 3 of the original Answer be and they are hereby dismissed without prejudice.

3. That Defendants' Counterclaim as expressed in prayer 5 of its amended Answer be and it is hereby dismissed with prejudice.

4. That Defendants recover of Plaintiff their costs herein to be taxed by the Clerk.

Signed and Entered at Denver, Colorado, this 25 day of August, 1954.

By the Court:
William Lee Knous
Judge of the U. S. District Court

Entered on the docket Aug. 25, 1954.

FILED
MAY 8 1956
HAROLD B. WILLEY, Clerk

IN THE

SUPREME COURT OF THE UNITED STATES

OCTOBER TERM, 1955

No. 761

OLIN MATHIESON CHEMICAL CORPORATION, a Corporation, Petitioner,

v.

THE WESTERN STATES CUTLERY AND MANUFACTURING COMPANY, a Corporation; H. REGINALD PLATTS, HARLOW C. PLATTS, DEBBIE C. PLATTS, LOIS M. PLATTS, and MARIAN K. PLATTS, Doing Business under the Name and Style of WESTERN STATES CUTLERY COMPANY; and WESTERN STATES CUTLERY COMPANY, a Colorado Corporation, Respondents.

ON PETITION FOR A WRIT OF CERTIORARI

To the United States Court of Appeals for the Tenth Circuit

BRIEF FOR RESPONDENTS IN OPPOSITION

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IN THE

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THE WESTERN STATES CUTLERY AND MANUFACTURING COMPANY, a Corporation; H. REGINALD PLATTS, HARLOW C. PLATTS, DEBBIE C. PLATTS, LOIS M. PLATTS, and MARIAN K. PLATTS, Doing Business under the Name and Style of WESTERN STATES CUTLERY COMPANY; and WESTERN STATES CUTLERY COMPANY, a Colorado Corporation, Respondents.

ON PETITION FOR WRIT OF CERTIORARI

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OPINIONS BELOW

The opinion of the District Court (App. B of Petition) is unreported. Findings of Fact and Conclusions of Law of the District Court (R. 32-42). The opinion of the Circuit Court of Appeals for the Tenth Circuit (App. A of Petition) is reported at 227 F. (2d) 728.

JURISDICTION

The jurisdictional requisites are adequately set forth in the Petition.

STATEMENT OF THE CASE

We cannot accept the statement of the case as contained in the Petition as being complete and submit the following additional statement.

The Trial Court found as a fact (R. 34 Paragraph 5) that The Western States Cutlery and Manufacturing Company (one of the Respondents) was organized under the laws of the State of Colorado in 1913 and as early as 1920 began the manufacture of cutlery including pocket knives. At least as early as the beginning of the nineteen-thirties it began the manufacture and sale of hunting or outdoor knives, some of which were stamped on the tangs with the word "WESTERN", or with "WESTERN Boulder, Colorado", with the Boulder, Colorado printed in smaller type. The practice of marking some of the hunting knives with "WESTERN", or with "WESTERN Boulder, Colorado" continued to the date of the trial. The cutlery products of Respondents have been extensively sold throughout the United States and in Canada and Mexico (Paragraph 5 of F.).

In Paragraph 8 of Findings of Fact (R. 35) the Trial Court found in substance: since as early as 1918 The Western States Cutlery and Manufacturing Company and its successors have employed the practice of issuing catalogs from time to time disclosing the cutlery products which it offered for sale, and beginning in the early nineteen-thirties the hunting knives and later the axes were advertised in these catalogs under the name "WESTERN", "WESTERN Boulder, Colorado", "Western States" and "West-Cut". Beginning in 1944 the products of the Respondents were advertised in national magazines. In addition thereto, other advertising matter including catalogs was

published and distributed in connection with which the trademark "WESTERN" or "WESTERN Boulder, Colorado" was prominently displayed and a substantial quantity of the products so advertised were impressed with the mark "WESTERN" or "WESTERN Boulder, Colorado".

The Trial Court found as a fact (F. of F. 9, 10, 11, R. 36) as follows:

> "9. That beginning in the early nineteen-twenties defendant, The Western States Cutlery and Manufacturing Company, adopted the practice of showing its products in the retail establishments where the goods were offered for sale by employing display cases and since the inception of the use of display cases the practice has been continued. The display cases, prior to *sometime* in the nineteen-forties, all prominently displayed thereon the words "Western States", and subsequently displayed thereon the word "Western" alone or in some instances the words "Western Cutlery" with "Cutlery" in smaller letters than "Western".
>
> "10. The defendants, beginning early in the nineteen-forties, marked some of its line of pocket knives and other knives, such as fish knives, with the word "Western" or "Western, Boulder Colorado" on the tangs thereof, and after World War II this type of mark for pocket knives and other knives was employed throughout the whole line of knives and other cutlery products made and sold by defendants, including axes which were manufactured and sold by the defendants as early as the middle nineteen-thirties.
>
> "11. Defendant's hunting knives, outing knives, pocket knives, axes and other cutlery products are sold through many retail outlets including sporting goods stores and hardware stores where plaintiff's ammunition is also sold.

In addition, the defendant's products are sold in cutlery sections of department stores, drug stores, cutlery departments of hardware stores, etc. Defendant's products, including hunting knives, fish knives, pocket knives and axes, are bought and used by ranchers, fishermen, picnickers, vacationers, boy scouts and hunters."

The Trial Court also found as a fact (F. of F. 14, R. 37) that:

"14. Plaintiff produced no evidence that during the entire period from the early nineteen-thirties to the present time that any individuals of the purchasing public were confused as to the origin of the products being sold by the plaintiff and defendant . . ."

ARGUMENT

I.

THE DECISION BELOW IS CLEARLY CORRECT

The Trial Court found as a fact that the Respondents had been marking their products "WESTERN" or "WESTERN Boulder, Colorado" since the early nineteen-thirties. That there was no evidence of confusion as to the origin of the products being sold by the Petitioner and Respondents. There was evidence offered by Respondents that there was no likelihood of confusion of the use of the word "WESTERN" on the products of the Respondents. All issues of fact were found in favor of the Respondents. The fact that there was no evidence of confusion of the source of origin of the products being manufactured and sold by the Petitioner and Respondents over a period of some twenty-five years should be conclusive proof that there is no likelihood of confusion in the future.

"If the actor (Respondents) has used his designation for a long time, the likelihood of mistaken association may be smaller than when he has used it for only a short time . . ." A.L.I. Restatement of the Law of Torts, Section 731, Comment f on Clause h.

"(19) Perhaps the best test of whether certain acts are likely to deceive is whether after being continued for a series of years they have in fact deceived. The evidence here is lacking to prove that the public have been misled, or that substantial confusion has been created."

LaPointe Machine Tool Co. v. J. N. LaPointe Co., 150 Me. 472, 99 ATL. 348, 354.

II.

NO SPECIAL AND IMPORTANT REASONS EXIST FOR THE GRANTING OF THE PETITION.

On page 11 of the Petition for Writ of Certiorari is found the following:

"This Court has never laid down any criteria for testing the relationship between goods as concerns the likelihood of confusion as to source . . . . . Until this Court speaks on the subject and provides the lower Courts with some guide posts, confusion and conflict may be expected to continue . . . . . ."

Petitioner seeks to have this Court announce a set of rules to guide the lower Courts in their decisions. This Court will not and cannot fix a "yardstick" to be used by the lower Courts in measuring whether or not there is confusion as to the source of origin of goods.

The Petition further states on page 11 that the discord on the subject is illustrated by cases cited in the Petition. In seven of

the cases cited this Court denied Petitions for Writ of Certiorari. Certainly if there had been a conflict in those decisions this Court would have rectified the conflict and granted Petition for Writ of Certiorari. In view of the fact that no Petition for Writ of Certiorari was granted by this Court it can be assumed that this Court did not feel that there was any conflict.

Two of the cases cited were cases which are now before this Court on Petitions for Writ of Certiorari (Nos. 658 and 662). In case No. 658, which is North American Aircoach Systems, Inc., et al. v. North American Aviation, Inc., 107 USPQ 68 (CA 9); the District Court held that the North American Aviation, Inc. had the exclusive right to use the trade-mark "North American" in all branches of aviation. The Petitioner in that case sought to use the trade-mark "North American" in a branch of aviation.

In the other case, which is National Dryer Manufacturing Corporation et al. v. The National Drying Machinery Company, 228 F. (2d) 349, both parties were using the word "National" in connection with the sale of drying machines.

In the case now before this Court there is no similiarity whatsoever between the goods manufactured and sold by the Petitioner and the goods manufactured and sold by the Respondents.

The Trial Court in Admiral Corp. v. Penco, Inc., 203 F. (2d) 517 (CA 2) found "deliberate palming off by defendant of its products under the trade-mark 'Admiral' ". The Court also found that there was actual confusion as to source of origin of the products.

In the case of Independent Nail & Packing Co., Inc., v. Stronghold Screw Products, Inc., 205 (2d) 921 (CA 7) the Court on page 926 stated:

> "Plaintiff and defendant were and are in competition with each other. Both sell throughout the United States. Both contact the same prospective customers through direct mail advertising and through listings in trade publications and directories usually used by purchasing agents. They sell products which are interchangeable in use. Defendant circularizes its catalogue to plaintiff's customers."

All reasons asserted in the Petition for the granting of the Writ of Certiorari are merely abstract or academic. This is not sufficient under the rule.

> Rice v. Sioux City Memorial Park Cemetery, 75 S. Ct. 614. 349 U.S. 70.

III.

THE LANGUAGE OF THE TRADE-MARK ACT OF 1946 IS CLEAR AND THERE IS NO NECESSITY FOR CONSTRUCTION BY THIS COURT.

The 1946 Trade-Mark Act extended protection to all goods:

> " 'on or in connection with which such use (of the mark) is likely to cause confusion or mistake or to deceive purchasers as to the source of origin of such goods.' "

The Court will remember that the Respondents began marking their products "WESTERN" and advertising the same under the trade-mark "WESTERN" in the early nineteen-thirties. They continued to do this until the trial of the case which was in February 1954. The Respondents had been using the word "WESTERN" on its products and advertising the same for some fifteen years before the enactment of the 1946 Act.

The question as to whether or not the use by the Respondents of the word "WESTERN" on its cutlery is likely to cause confusion or mistake or deceive purchasers as to the source of

origin of such goods, was decided against the Petitioner by the Trial Court. The Court of Appeals also found that there was no evidence of likelihood of confusion.

IV.

THE DECISION OF THE EXAMINER OF INTERFERENCES IN AN OPPOSITION PROCEEDING IS NOT CONCLUSIVE IN A PROCEEDING INVOLVING THE RIGHT TO THE USE OF A TRADE-MARK.

In 1932 the Respondent, The Western States Cutlery and Manufacturing Company, filed an application to register the word "WESTERN." The Petitioner filed an opposition to this application. The Examiner of Interferences sustained the opposition. That was a proceeding to determine the right of the Respondent to register the word "WESTERN."

The Case of Morgan v. Daniels, 153 U.S. 120, demonstrates that this case is not in conflict with the cases cited on page 17 of the Petition. In Morgan v. Daniels an application was made to the Court to set aside a decision of the Patent Office. The Court held that the decision would stand unless the testimony was sufficient to show that the decision should be set aside.

At page 18 of the Petition it is stated that this case is in direct conflict with the decision of the Ninth Circuit in Safeway Stores v. Dunnell, 172 F. (2d) 649. This is not correct. In Safeway Stores v. Dunnell, Dunnell applied for registration of a trade-mark and Safeway Stores opposed. The application to register was denied. Dunnell brought a suit in a District Court to require the registration of the trade-mark. The District Court ruled in his favor. Safeway Stores appealed to the Court of Appeals and that Court held that the Court was bound by the testimony taken before the Examiner of Interferences. That was a proceeding as to the right to register. There was no ques-

tion in either Morgan v. Daniels or Safeway Stores v. Dunnell as to the question of the right to use a trade-mark.

The case before the Court is a proceeding to determine the right of the Respondents to USE the word "WESTERN" on its products and to advertise the same.

No case is cited in the Petition that in any way holds that a decision of the Patent Office in a proceeding to REGISTER a trade-mark is binding on the Court in a proceeding where the issue is the right to USE.

The Commissioner of Patents recognizes the difference between the issue raised in an opposition proceeding and the issue raised in a suit involving unfair competition in the following cases:

> General Motors Corp. v. The B. A. Wesche Electric Co., 70 USPQ 454.
> Landis Tool Co. v. Landis Machine Co., Inc., 89 USPQ 42-44.

The Seventh Circuit in John Morrell and Co. v. Doyle et al., 97 F. (2d) 232 at 234, said:

> "'(1) . . . The issue there was merely the right to register, while here is presented, as disclosed by plaintiff's bill, the right to the use of the word Strongheart in connection with the manufacturing and sale of dog foods from which it necessarily follows that it is the use which is complained of . . . The Court of Customs and Patent Appeals, as its opinion clearly indicates and as was incumbent upon it, in determining defendants' right to register, reached the conclusion that there was likelihood of confusion in trade, by reason of the similarity of the marks. This was nothing more than an opinion, the accuracy of which only the future might reveal. It was not a determination of an exist-

ing or past fact or event, but was of a speculative nature as to what was likely to subsequently occur. The issue here is not what may occur, but what has actually taken place. The bill is thus predicated, otherwise no cause of action is stated . . .

" 'Many courts have held the rule of res judicata inapplicable and some have even gone so far as to hold that the decision of the Patent Office is not even persuasive.' (citing numerous cases) (235) "

The First Circuit in Mishawaka R. and W. Mfg. Co. v. Panther-Panco Rubber Co., 153 F. (2d) 662, 665, used this language:

" '(2) It is conceded by plaintiff that the decision of the Patent Office in the opposition proceeding is not res judicata. John Morrell and Co. vs. Doyle, 7 Cir., 1938, 97 F. 2d 232. While such decision may be entitled to weight, as the court below recognized, yet in the circumstances of this case we agree that it is not controlling.' "

There are no cases in conflict with the above.

CONCLUSION

In conclusion, for the foregoing reasons, it is respectfully submitted that this Petition for Writ of Certiorari should be denied.

Respectfully submitted,

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MAY 9 1956
HAROLD B. WILLEY, Clerk

IN THE

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On Petition for Writ of Certiorari to the United States Court of Appeals for the Tenth Circuit.

PETITIONER'S REPLY BRIEF.

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